

**REMARKS**

**I. Status of th Claims**

Claims 1-3, 5-9, 11-30, and 32-56 are now pending in this application. Claims 4, 10, and 31 have been cancelled without prejudice or disclaimer. Claims 1, 30, 33, 55, and 56 have been amended to delete selected second oxidation bases. These amendments are proper because Applicant is simply claiming less than the full scope of her original disclosure -- a perfectly legitimate procedure since it is for the inventor to decide what bounds of protection she will seek. See, e.g., *In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977).

Accordingly, no new matter has been added by these amendments nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Applicant believes that the proposed amendments place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

**II. Rejections under 35 U.S.C. § 103**

**A. Henkel in view of Tsujino**

Claims 1-27, 30-34, and 37-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel (WO 92/13824) in view of Tsujino (U.S. Patent No. 4,961,925) for the reasons set forth on pp. 2-4 of the Final Office Action.

The Examiner states that it would have been obvious "to add a second oxidation base to Henkel's exemplified compositions in the claimed amounts ... and Tsujino teaches that the claimed second oxidation bases are conventional in the hair dyeing art." Final Office Action at p. 4.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Applicant respectfully disagrees for reasons of record. Nevertheless, to advance prosecution, independent claims 1, 30, 33, 55, and 56 have been amended to delete certain second oxidation bases. Thus, only a very specific, smaller set of bases is currently claimed. Neither Henkel nor Tsujino recognizes the significance of this very particular, smaller set of bases, let alone their combination with another oxidation base and a coupler.

To further support their position of the non-obviousness of the particular components of the presently claimed compositions, Applicant submits herewith a Declaration under 37 C.F.R. § 1.132 to show unexpectedly good results for inventive compositions containing one of paraphenylenediamine, N,N-bis(β-hydroxyethyl) paraphenylenediamine monohydrate sulfate, and 2-(β-hydroxyethyl) paraphenylene diamine dichlorohydrate, as a second oxidation base. These oxidation bases are among the specific set of claimed bases. The Declaration describes comparative testing between inventive compositions 1-3 and comparative compositions 4-6, which contain an additional oxidation base that is not in accordance with the invention, e.g., one of 1-methoxy-2,5-diamino benzene dichlorohydrate, 2-methyl 4-amino phenol, or orthoaminophenol.

In the comparative test, compositions 1-6 are used to dye hair, which is then subjected to a "suntest," i.e., exposure to a Xenon lamp emitting a UV radiation between 300 and 380 nm. The color of the hair was determined before and after the suntest according to the formula:

$$\Delta E = \sqrt{(L^* - L_o^*)^2 + (a^* - a_o^*)^2 + (b^* - b_o^*)^2}$$

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

wherein  $L^*$  indicates lightness,  $a^*$  and  $b^*$  are the chromaticity coordinates of the colored locks after the suntest,  $L_0^*$  indicates the lightness, and  $a_0^*$  and  $b_0^*$  are the chromaticity of the colored locks before the suntest. The lower the value of  $\Delta E$ , the more resistant is the color of the dyed hair.

As shown in Table II of the Declaration, hair dyed with inventive compositions 1-3 exhibits unexpectedly low values of  $\Delta E$  compared to hair dyed with comparative compositions 4-6. In other words, hair dyed with inventive compositions 1-3 shows a much smaller variation in color after the suntest compared to hair dyed with comparative compositions 4-6. Thus, the color of hair dyed with compositions according to the invention (1, 2 and 3) is unexpectedly more resistant to prolonged exposure to UV radiation than the color of hair dyed with the non-inventive compositions (4, 5 and 6). According to the inventor, these significantly superior results were surprising and unexpected. One of the basic requirements to establish a *prima facie* case of obviousness is a reasonable expectation of success. M.P.E.P. § 2143.02. "Applicant may present evidence showing there was no reasonable expectation of success." *Id.*

Applicant respectfully submits that such a showing was made here. Based on the comparative tests, where the result depends on the particular combination of components used, e.g., which oxidation base was used as the additional oxidation base, there is no reasonable expectation of success that the selected oxidation bases claimed would produce unexpectedly good results over other oxidation bases. There is simply no basis for a reasonable expectation, based on the teachings of the references, of the superior results that occurred for some but not all of the combinations of ingredients based on the variation of the second oxidation base.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Accordingly, no *prima facie* case of obviousness can be made over Henkel in view of Tsujino. Applicant respectfully requests withdrawal of this rejection.

**B. Andrillon in view of Henkel**

Claims 1-7, 9-13, 15-38, 41-53 and 55-56 are rejected under 35 U.S.C. §103 over Andrillon (U.S. Patent No. 4,065,255) in view of Henkel (WO 92/13824) for the reasons set forth on pp. 4-7 of the Office Action. Applicant respectfully traverses this rejection for reasons of record and the following additional reasons.

Andrillon teaches the use of a particular class of couplers in oxidation dye compositions. Andrillon, however, fails to teach compositions comprising 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane. The Examiner cites Henkel to remedy this deficiency. The Examiner apparently believes that the combination is supported by Andrillon's teaching that mixtures of oxidation bases may be used. Office Action at p. 6, last 2 lines.

Applicant respectfully disagrees. Andrillon teaches the advantages of a particular class of couplers. Andrillon, however, does not teach that these couplers will especially benefit a composition comprising 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane or any phenoxy oxa-alkanes. While Andrillon's teaching may support the broad idea that more than one oxidation base can be used in hair dye compositions, there is no teaching or suggestion in either reference that a composition comprising Andrillon's coupler, 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane, and a second oxidation base is particularly desirable. Henkel does not remedy this deficiency because Henkel does not teach the use of Andrillon's specific couplers. "The prior art must suggest the desirability of the claimed invention." M.P.E.P. § 2143.01. As neither

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Andrillon nor Henkel provide this suggestion, a *prima facie* case of obviousness has not been established.

Nevertheless, as discussed above, independent claims 1, 30, 33, 55, and 56 have been amended to recite a specific set of bases. Neither Andrillon nor Henkel provides a specific suggestion or motivation to use any of the second oxidation bases as claimed in amended claims 1, 30, 33, 55, and 56, with 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane.

Regarding independent claims 28 and 29, neither Andrillon nor Henkel teach the benefits of compositions comprising the combination of specific components set forth in these two claims. A *prima facie* case of obviousness made against these claims requires evidence of a specific suggestion from the art, as such evidence must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). See also *In re Lee*, 377 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority."). As the Examiner has failed to show how the references teach or suggest the specifically claimed combination of ingredients, a *prima facie* case of obviousness has not been established for claims 28 and 29.

In view of the above, Applicant respectfully requests withdrawal of this rejection.

### III. Conclusion

In view of the foregoing, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 15, 2003

By: Thalia V. Warnement  
Thalia V. Warnement  
Reg. No. 39,064

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com